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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/822,500	04/02/2001	Boaz Nitzan	1328	7527

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EXAMINER

WEBB, GREGORY E

ART UNIT	PAPER NUMBER
1751	5

DATE MAILED: 07/23/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application N . 09/822,500	Applicant(s) NITZAN ET AL.	
	Examiner Gregory E. Webb	Art Unit 1751	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 14 June 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-24 is/are pending in the application.
- 4a) Of the above claim(s) 1-5 is/are withdrawn from consideration.
- 5) ☐ Claim(s) 6-24 is/are allowed.
- 6) ☐ Claim(s) _____ is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) <u>3</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 112

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claims 19 and 22 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

3. A broad range or limitation together with a narrow range or limitation that falls within the broad range or limitation (in the same claim) is considered indefinite, since the resulting claim does not clearly set forth the metes and bounds of the patent protection desired. Note the explanation given by the Board of Patent Appeals and Interferences in *Ex parte Wu*, 10 USPQ2d 2031, 2033 (Bd. Pat. App. & Inter. 1989), as to where broad language is followed by "such as" and then narrow language. The Board stated that this can render a claim indefinite by raising a question or doubt as to whether the feature introduced by such language is (a) merely exemplary of the remainder of the claim, and therefore not required, or (b) a required feature of the claims. Note also, for example, the decisions of *Ex parte Steigewald*, 131 USPQ 74 (Bd. App. 1961); *Ex parte Hall*, 83 USPQ 38 (Bd. App. 1948); and *Ex parte Hasche*, 86 USPQ 481 (Bd. App. 1949). In the present instance, claim 19 recites the broad recitation "organic esters", and "ketones". The claim also recites preferred compounds such as "ethyl acetate" which is the narrower statement of the range/limitation. Similarly, claim 22 recites glycol ethers and cyclic ethers and preferred glycol ethers such as "dipropylene glycol methyl ether." As it is unclear

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whether the broadly claimed groups or the specific compounds are being claimed, the examiner will read these claims in their broadest sense.

4. Claim 22 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claim 22 currently recites the tradename solvent "butyl carbitol". It is suggested for reasons of clarity that such tradenames be replaced with the proper chemical terminology, namely "diethylene glycol monobutyl ether."

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. Claims 6, 7, 9-18, 22, and 23 are rejected under 35 U.S.C. 102(b) as being anticipated by Kukharskay et al (SU 1058453A).

7. Kukharskay teaches liquid compositions containing 10.1-16.8% glycol ethers, 0.014-0.023% hydrochloric acid, 3-5% ferric chloride, 3-5% copper chloride, and water.

8. Concerning the applicant's claims to specific ranges of pH, as the prior art meets all specific compositional limitations of the instant claims, more particularly the claims meet limitations to the inorganic acid component, such properties as pH, which are affected by acid compounds such as hydrochloric acid, would be clearly inherent to the compositions of Kukharskay and would thus fall within the applicant's claimed ranges of pH.

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9. Claims 6, 7, 9-12, 19, 20, 22, and 23 are rejected under 35 U.S.C. 102(b) as being anticipated by Figov et al (GB 1,492,529).

10. Figov teaches in example 1 a composition containing 1.8% phosphoric acid, 10% diethylene glycol, 10% ethyl lactate, and water. Figov teaches in example 2 a composition containing 1.8% phosphoric acid, 10% diethylene glycol, 10% diethylene glycol monobutyl ether (butyl carbitol), 38% isopropanol, and 40% water.

11. Concerning the applicant's claims to specific ranges of pH, as the prior art meets all specific compositional limitations of the instant claims, more particularly the claims meet limitations to the inorganic acid component, such properties as pH, which are affected by acid compounds such as hydrochloric acid, would be clearly inherent to the compositions of Figov and would thus fall within the applicant's claimed ranges of pH.

12. Claims 6-24 are rejected under 35 U.S.C. 102(b) as being anticipated by Matsumoto et al (US 5,064,749).

13. Matsumoto teaches in example 2 a composition containing 2.0% nickel nitrate, 2% phosphoric acid, 10% dipropylene glycol monomethyl ether, and water.

14. Matsumoto teaches a combination of an aqueous phase solution with an oil phase solution to form an emulsion (see col. 11, lines 1-20). The emulsion contains phosphoric acid, water, and esters (rosin ester and dioctyl phthalate).

15. Matsumoto teaches in example 3 a composition containing magnesium nitrate, phosphoric acid, methoxypropanol (a glycol ether), and water.

16. Matsumoto teaches these compositions to have a pH of between 3 to 7 (see col. 4, lines 38-63).

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17. Claims 6-12, and 22-24 are rejected under 35 U.S.C. 102(b) as being anticipated by Gautier et al (US 4,540,448).

18. Gautier teaches a microemulsion composition containing 6.4% phosphoric acid, 20.2% water, 9.7% 2-ethylhexanol, and surfactant (see example 1).

19. Gautier teaches a composition (see example 12) containing 16.5% phosphoric acid, 1.85% ethylene glycol monobutyl ether, and water.

20. Concerning the applicant's claims to specific ranges of pH, as the prior art meets all specific compositional limitations of the instant claims, more particularly the claims meet limitations to the inorganic acid component, such properties as pH, which are affected by acid compounds such as hydrochloric acid, would be clearly inherent to the compositions of Gautier and would thus fall within the applicant's claimed ranges of pH.

21. Claims 6, 7, 9-12, and 22-24 are rejected under 35 U.S.C. 102(b) as being anticipated by Herdt et al (US 6,121,219).

22. Herdt teaches compositions containing 0.1-80% phosphoric acid, 0.1-40% ether solvent, and water (see table 1).

23. Herdt teaches in example 11 a composition containing 5% glycol ether (butoxy ethanol), 45% phosphoric acid, and 9% water.

24. Herdt teaches these compositions to have a pH in the range of 1-5 (see col. 3, lines 8-20).

25. Claims 6, 7, 9-12, 19, and 22 are rejected under 35 U.S.C. 102(b) as being anticipated by Beggs et al (US 6,017,968).

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26. Beggs teaches a composition in example 9 containing water, 5% nitric acid, 45% propylene glycol t-butyl ether, and 30% N-methyl-2-pyrrolidone.

27. In example 10 Beggs teaches a composition with a pH of 3.3 containing water, nitric acid, and propylene glycol.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gregory E. Webb whose telephone number is 703-305-4945.

The examiner can normally be reached on 9:00-17:30 (m-f).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Yogendra Gupta can be reached on (703)308-4708. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9310 for regular communications and 703-872-9310 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703)308-0661.



Gregory E. Webb
Examiner
Art Unit 1751

gw
July 18, 2002